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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.												
10/510,532	10/07/2004	Gerd Ascher	KS4255US (#90711)	8872												
<div style="display: flex; justify-content: space-between;"><div><p>7590 07/02/2008</p><p>D. Peter Hochberg, Esq. D. Peter Hochberg, Co., L.P.A. 1940 East 6th Street - 6th Floor Cleveland, OH 44114</p></div><div><table border="1"><tr><td colspan="2">EXAMINER</td></tr><tr><td colspan="2">CLAYTOR, DEIRDRE RENEE</td></tr><tr><td>ART UNIT</td><td>PAPER NUMBER</td></tr><tr><td colspan="2">1617</td></tr><tr><td>MAIL DATE</td><td>DELIVERY MODE</td></tr><tr><td>07/02/2008</td><td>PAPER</td></tr></table></div></div>					EXAMINER		CLAYTOR, DEIRDRE RENEE		ART UNIT	PAPER NUMBER	1617		MAIL DATE	DELIVERY MODE	07/02/2008	PAPER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/510,532

Applicant(s)

ASCHER ET AL.

Examiner

Renee Claytor

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 4/27/2005
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's election of I-Valnemulin as the pleuromutilin agent and active chronic gastritis is as the disease in the reply filed on 12/14/2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections – 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2 and 5-7 provides for the use of a pleuromutilin in the preparation of a medicament for the treatment of diseases mediated by *Helicobacter pylori*, but since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 1-2 and 5-7 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App.

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1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966). For the sake of compact prosecution, the claims are being interpreted as a method for the treatment of diseases mediated by *Helicobacter pylori* comprising administration of an effective amount of a pleuromutilin.

Claim 5 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, within the structure given in the claim, the "O" at the 14 position of the ring structure does not have a substituent indicating the addition of a group. Claim 6 further limits claim 5, and the "O" at the 14 position is connected to a group or formula. Applicant is directed to complete claim 5 by putting another "R" group to exemplify the invention. For the sake of compact prosecution, the claim is being read with the "O" at the 14 position being open to contain any group or formula.

Claims 1-7 rejected under 35 U.S.C. 112, first paragraph, because the specification, does not reasonably provide enablement for treating diseases mediated by *Helicobacter pylori*, and in particular chronic gastritis. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

The how to make requirement of the enablement statute, when applied to process claims, refers to operability and how to make the claimed process work. "The factors to be considered [in making an enablement rejection] have been summarized as

the quantity of experimentation necessary, the amount of direction or guidance presented, the presence or absence of working examples, the nature of the invention, the state of the prior art, the relative skill of those in the art, the predictability or unpredictability of the art and the breadth of the claims", *In re Rainer*, 146 USPQ 218 (1965); *In re Colianni*, 195 USPQ 150, *Ex parte Formal*, 230 USPTQ 546.

1) The nature of the invention and breadth of the claims: The nature of the invention and breadth of the claims is drawn to a method for the treatment of diseases mediated by *Helicobacter pylori* (chronic gastritis is the elected species) comprising administration of an effective amount of a pleuromutilin.

2) The presence or absence of working examples and the amount of direction or guidance presented: The determination of a particular claimed compound in the treatment of diseases mediated by *Helicobacter pylori*, and in particular chronic gastritis, requires the synthesis of the compound, formulation in a suitable dosage form, and testing in a known assay that is correlated with clinical efficacy. The only examples presented by Applicant in the specification are *in vitro* tests showing that I-Valnemulin has an effect on *H. pylori* (pages 55-56). There is no data in accepted models of chronic gastritis suggesting that these compounds would show clinical efficacy in treating this disease.

The issue in *Ex parte Balzarini* 21 USPQ2d 1892 concerned HIV treatment and the Board of Patent Appeals and Interferences wrote "while the *in vitro* testing performed on these anti-viral compound appears to be useful as a screening tool in order to determine which of these anti-viral compounds are candidates for further

testing to determine if they possess *in vivo* utility, the *in vitro* tests were not predictive of *in vivo* efficacy". Furthermore, the issue in *Fujikawa v. Wattanasin* 39 USPQ2d 1895 was adequacy of *in vitro* testing of inhibitors of cholesterol biosynthesis and U.S. Court of Appeals Federal Circuit wrote, "*in vitro* results, in combination with a known correlation between such *in vitro* results and *in vivo* activity, may be sufficient to establish practical utility". A working example in *in vivo* experiments showing that the compounds would effectively treat the claimed diseases is lacking.

3) The state of the prior art: The "amount of guidance or direction" refers to that information in the application, as originally filed, that teaches exactly how to make or use the invention. The more that is known in the prior art about the nature of the invention, how to make, and how to use the invention, and the more predictable the art is, the less information needs to be explicitly stated in the specification. In contrast, if little is known in the prior art about the nature of the invention and the art is unpredictable, the specification would need more detail as to how to make and use the invention in order to be enabling. >See, e.g., *Chiron Corp. v. Genentech Inc.*, 363 F.3d 1247, 1254, 70 USPQ2d 1321, 1326 (Fed. Cir. 2004).

A review article by Malfertheiner et al. (*Aliment Pharmacol Ther* 2002; 16: 167-180) points out therapies for the management of *Helicobacter pylori*. Beginning on page 173, Malfertheiner et al. discusses therapy and management which include proton pump inhibitors and ranitidine bismuth, among other treatment regimens. However there is no mention of treatment with valnemulin or any pleuromutilin.

Substantiation of use and scope is required when the use is "speculative", "sufficiently unusual" or not provided in the specification, *Ex parte Jovanovics*, 211 USPQ 907, *In re Langer*, 183 USPQ 288, *Hoffman v. Klaus*, 9 USPQ2d 1657, and *Ex parte Powers*, 200 USPQ 925 concerning the type of testing needed to support *in vivo* use claims. Also see MPEP § 2164.03 for enablement requirements in the structure sensitive arts of pharmacology and medicinal chemistry.

4) The quantity of experimentation necessary: "A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed Cir. 1993)". Undue experimentation would be required in order to practice Applicant's invention because there are no examples provided in the specification. One would have to determine a useful model that correlates with clinical efficacy, a dosage range would need to be determined as well as a route of administration. Further, if any of the above failed, then the artisan would have to start over again in an effort to determine the suitable methods, dosage ranges and routes of administration in which to determine if the compounds will work to treat chronic gastritis.

Conclusion

No claims are allowed.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Renee Claytor whose telephone number is (571)272-8394. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Renee Claytor

/SREENI PADMANABHAN/
Supervisory Patent Examiner, Art Unit 1617

